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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,989

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Bernhard Bohmer

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EXAMINER

PIRI, ALDRIN J F

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,989

**Applicant(s)**

BOHMER ET AL.

**Examiner**

Aldrin Piri

**Art Unit**

4125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 3/1/2005.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the first action in response to the correspondence filed on 01 March 2005.
2. Claims 1-12 are pending in the application. Claim 1 is an independent claim.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

3. **Claim 1** is objected to because of the following informalities: The first limitation of the amended claims recites "retrieving presence data via..." which is a typographical error and should read "retrieving presence data via...". Appropriate correction is required.
4. **Claim 4** is objected to because of the following informalities: The first limitation of the amended claims recites "...describing the structure of the list, which have already been transmitted..." which is a typographical error and should read "...describing the structure of the list, which has already been transmitted...". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-8** are rejected under 35 U.S.C. 102(a) as being anticipated by Malik et al. (US 7,016,978 B2), hereinafter referenced as Malik.

5. With regards to **claim 1**, Malik teaches showing a list including presence data on a display unit on a first communication terminal where the presence data are stored on a presence computer, comprising:

- retrieving presence data (Column 6, Lines 34-42; wherein Local and Universal IM Servers transmit presence data to a requesting first client) via a list generation device (Column 6, Lines 25-42; wherein the Universal IM server is able to collect a list of remote clients of interest, by deriving selected users from a contact list or roster on the first client) using a retrieval message from the presence computer (wherein the Universal IM server also acts as the presence computer), the presence data relating to a predetermined selection of further communication terminals which are associated with users (Column 6, Lines 27-29; wherein selected users of interest on the Universal IM server are derived from a first client's contact list or roster);

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- ascertaining format data which are associated with the first communication terminal and which describe a data format which can be shown on the display unit of the first communication terminal (Columns 8-9, "Universal Instant Messaging Architecture"; wherein if a second user contacted by a first user is on a same network, the proprietary communication will be made within that network, but if the user should belong to a different proprietary network, the respective IM clients will operate in a universal mode, allowing transparent translation of the messages between protocols);
  - using the format data to condition the presence data such that a list is produced which has the displayable data format (Columns 8-9, "Universal Instant Messaging Architecture"; wherein the Universal IM server handles the translation of Presence information between protocols); and
  - transferring the list to the first communication terminal for display on the display unit (Column 10, Lines 23-31; wherein both Local and Universal servers get Presence information which is derived from a first user's contact list and relay that information back to them, as suggested later in Lines 60-61).
6. With regards to **claim 2**, Malik further teaches wherein the format data are ascertained by virtue of the list generation device receiving a type information item from the first communication terminal, and the type information item is used by the list generation device to read the format data from a data store (Columns 8 and 9, Lines 53-67 and 1-16, respectively; wherein it is disclosed that an

intelligent handling of message requests for users on a same network and a second network can be discerned. For instances where other users of interest to a first user are on a different network/protocol, the Universal IM server is capable of retrieving stored IP and presence information of that client and providing a transparent translation of information to the protocol the first user is on).

7. With regards to **claim 3**, Malik further teaches wherein the list generation device retrieves from the presence computer, as presence data, data which describe an opportunity for communication between the first communication terminal and the further communication terminals at the time of retrieval (Column 5, Lines 51-65; wherein the presence information disclosed is inclusive of various devices a person is capable of being reached on, connection options, and states. Furthermore, in Column 14, Lines 4-9, it is disclosed that this technology is not limited to just instant messaging but also to text, audio, and video messaging as well as application to application communication).

8. With regards to **claim 4**, Malik further teaches wherein the list is generated using list structure data, describing the structure of the list, which have already been transmitted from the first communication terminal to the list generation device (Column 6, Lines 27-29; wherein selected users of interest on the Universal IM server are derived from a first client's contact list or roster).

9. With regards to **claim 5**, Malik further wherein the list is stored in the list generation device, and if further list structure data arrive after the time of storage then the list is adapted in line with these further list structure data (Column 10, Lines 35-39 and 60-67; wherein it is noted that a Universal IM server only tracks

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users from a differing network when added to a local user's roster, interpreted as polling for presence and other information when such a change occurs.

Furthermore, additional steps are disclosed in Column 11, Lines 51-64 are disclosed for handling the acquisition of new users).

10. With regards to **claim 6**, Malik further teaches wherein the list generation device receives a selection message which is transferred from the first communication terminal and which includes information about the predetermined selection of further communication terminals (Column 6, Lines 25-42; wherein the Universal IM server is able to collect a list of remote clients of interest, by deriving selected users from a contact list or roster on the first client, interpreted as being predetermined selection of terminals of interest for the first client).

11. With regards to **claim 7**, Malik further teaches wherein the list generation device uses the retrieval message to transfer the information about the predetermined selection of further communication terminals to the presence computer (Column 6, Lines 25-42; wherein the Universal IM server is able to collect a list of remote clients of interest, by deriving selected users from a contact list or roster on the first client), which then ascertains the presence data about these further communication terminals and transfers them to the list generation device (Column 10, Lines 23-39; wherein at login the lists or rosters of a user are interpreted for gathering the relevant connection and presence information of users, and is prepared for later transmittal to a client as in Column 10, Lines 60-67).

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12. With regards to **claim 8**, Malik further teaches wherein the presence computer ascertains the presence data by reading from a memory apparatus (Abstract; wherein it is disclosed that the Universal IM server is inclusive of a database, interpreted as a memory apparatus that stores routing and Presence information).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. **Claims 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik in view of Telia AB (EP 0 753 957 A2), hereinafter referenced as Telia.



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14. With regards to **claim 9**, Malik teaches all the limitations as above in claim 1, but fails to teach wherein the list generation device creates charging data which relate to the list which has been transferred to the first communication terminal. Malik only provides a mere suggestion of billing in that billing information would be included with personal information (Column 11, Lines 10-14).

15. Telia teaches a billing system for messages that are passed between telecommunications networks, wherein an electronic stamp is able to be purchased in advance, and upon sending a message, is used much like stamps in traditional paper mail settings, allowing for a debit account that can be prepaid, with the prior purchase of stamps. Upon the transmission of a message, a user is charged (Paragraphs [0009]-[0010]).

16. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the presence communications system of Malik with the message based billing system of Telia with the motivation being allowing communication with equipment in a public network and that debiting can be performed for a clear-cut way, providing for paying for communications in different types of networks (Paragraph [0012]).

17. With regards to **claim 10**, Malik and Telia teach the invention as disclosed with as above in claim 9, and Telia further teaches wherein the list generation device transmits the charging data to a first switching center (Paragraphs [0016]-[0017]), respectively; wherein a Message Center, C, acts as a switching center for the transmission of messages and further handles the collection and

processing of stamps used in transmission) in the first communication network, and the switching center then generates charge tickets associated with the charging data for the purpose of further processing in a charge credit device (Paragraphs [0016]-[0017]; wherein the Message Center further handles the interpretation of stamps applied to messages and checks for validity, whereupon use effectively debits the account of stamps that had been purchased at a prior time).

18. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the presence communications system of Malik with the message based billing system of Telia with the motivation being the same as applied in claim 9.

19. With regards to **claim 11**, Malik and Telia teach the invention disclosed as above in claim 9, and Telia further teaches wherein the list generation device sends the charging data to a service switching point in the first communication network, and the charging data are then taken as a basis for debiting a charge sum from a prepaid account which is associated with the first communication terminal center (Paragraphs [0016]-[0017]; wherein a Message Center, C, acts as a switching center for the transmission of messages and further handles the collection and processing of stamps used in transmission with the Message Center also handles the interpretation of stamps applied to messages and checks for validity, whereupon use effectively debits the account of stamps that had been purchased at a prior time. Furthermore, Figures 2-5 show the

positioning of the Message Center relative to the networks, and as a result, make it possible for the Message Center to be within the first communication network).

20. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik in view of Diacakis et al. (US 2002/0116461 A1), hereinafter referenced as Diacakis.

21. With regards to **claim 12**, Malik teaches all the limitations as above in claim 1, and further teaches activation of an image starts a communication program on the first communication terminal which allows communication between the first communication terminal and one of the further communication terminals (Column 10, Lines 60-67), but does not explicitly teach the activation of an image (only the mere recitation of selecting a user off a contact list). Malik also fails to teach wherein the presence data are shown on the display unit in the form of images associated with the presence data

22. Diacakis teaches a graphical user interface that uses various graphical indicia for how a user may be contacted (Figure 8, wherein the instant example provides showing of contact availability through phone and IM. Paragraphs [0056] and [0059]-[0060]; wherein other devices/communication protocols are disclosed as being capable of being depicted in a similar fashion).

23. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the messaging platform incorporating presence and availability data of Malik with the graphical display of a presence system of Diacakis with the motivation being providing a user friendly interface

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allowing subscribers to contact individuals without having to be concerned about different communication devices, their addresses and capabilities (Paragraph [0062]).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6,658,095 – Presence System that works off of profiles and has applications to billing as well as applied to internet capable devices outside the realm of just communications.
- US 2003/0036394 – A communications system, primarily SMS, that allows for prepaid message service to be accomplished as well as the relevant network structure to support it.
- US 6,301,609 – Messaging system that creates communications between a variety of different devices as well as handling of presence with various states of priority.
- US 6,449,344 – Provides a low level view of a communications system for a network with a plurality of terminals, and allowing an active seeking of users with which to communicate.
- “A SIP Event Package for Buddylist Presence” – Provides draft of requirement for implementing presence into buddy lists with which a person subscribes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aldrin Piri whose telephone number is 571/270-5078. The examiner can normally be reached on M-F, 7-5 (Alternating Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Garber can be reached on 571/272-2194. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aldrin Piri/  
Examiner, Art Unit 4125

/Charles Garber/  
Supervisory Patent Examiner, Art Unit 2800